No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTION PRESENTED

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). The question presented is as follows:

Whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application for registration.

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INTEREST OF THE UNITED STATES

This brief is submitted in response to the Court's order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be granted.

STATEMENT

1. The Copyright Act of 1976, 17 U.S.C. 101 *et seq.*, grants copyright protection to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102(a). Among other rights and benefits, copyright protection confers on owners the exclusive rights to copy, distribute, and perform the works. 17 U.S.C. 106. Anyone who violates these rights is "an infringer of the copyright" and may be liable for actual or statutory damages, injunctive relief, and attorney's fees and costs. 17 U.S.C. 501(a), 502, 503, 504, 505.

Since the initial Copyright Act of 1790, Act of May 31, 1790, ch. 15, 1 Stat. 124, Congress has provided for the official registration of copyrighted works. See generally Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958), reprinted in Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revisions: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 9-27 (Comm. Print 1960). Initially, each author was required, as a condition of copyright protection, to deposit a copy of his work in the clerk's office of the district court where the author resided so that the clerk could "record the same forthwith, in a book to be kept by him for that purpose." § 3, 1 Stat. 125. Under current law, the responsibility for registration rests with the Register of Copyrights as director of the Copyright Office. 17 U.S.C. 408(a), 410. "Such registration is not a condition of copyright protection." 17 U.S.C. 408(a). As described below, however, an author generally must register his work in order to commence an action for infringement or to obtain certain statutory remedies and evidentiary benefits.

a. A copyright owner "may obtain registration of the copyright claim by delivering to the Copyright Office" generally two copies of the work, along with an application containing information about the work and the application fee. 17 U.S.C. 408(a) and (b), 409. Upon receiving the copies, a compliant application, and the appropriate fee, the Register "examin[es]" the "material deposited" to determine whether the work "constitutes copyrightable subject matter" and whether "other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. 410(a).

If "after examination" the Register determines that the legal and formal requirements are satisfied, "the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a). The Office also enters the registration into its records catalog, creating an official public record of the work and of its copyrighted status. See 17 U.S.C. 705; U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 209 (3d ed. 2017) (*Compendium*). Records of post-1977 registered works are available on the Internet to be searched by the public. See U.S. Copyright Office, *Public Catalog*, http://cocatalog.loc.gov. If the Register instead finds that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration" and shall notify the applicant of that refusal. 17 U.S.C. 410(b).

This examination process often involves a dialogue between the Copyright Office and the applicant. For example, an examiner may "discover[] that the applicant failed to provide sufficient information in a particular field or space of the application or elsewhere in the registration materials, or [that] the applicant otherwise failed to meet the registration requirements." *Compendium* § 605.3(B). In the course of such correspondence, an owner can clarify the scope of his application or may withdraw or otherwise abandon his claim. *Id.* §§ 605.3(B), 605.7, 605.9.

Depending on the necessary correspondence and the complexity of the legal issues presented, the time to complete this process varies, but the average time for the Office to resolve a registration application is ap-

proximately eight months. Applicants may request expedited processing of their claims at any time, however, and for an additional fee "the Office will make every attempt to examine the application or the document within five working days." *Compendium* § 623.4; see *id.* § 623.6.[1] If the Register ultimately grants registration of a work, the effective date of that registration is the date on which the Copyright Office first received a proper application, deposit, and fee. See 17 U.S.C. 410(d).

b. Although registration is no longer a condition of copyright protection, the Copyright Act continues to provide a number of incentives for copyright owners to seek registration promptly.

As most relevant here, Section 411(a) provides that "no civil action for infringement of the copyright in any United States work shall be instituted until * * * registration of the copyright claim has been made in accordance with this title." 17 U.S.C. 411(a); see *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 157 (2010) (explaining that Section 411(a) establishes a nonjurisdictional precondition to suit).[2] Absent an allegation that the owner knowingly submitted an inaccurate application, the Register's issued certificate of registration "satisfies the requirements of" Section 411. 17 U.S.C. 411(b). Section 411(a) further provides that, "[i]n any case * * * where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement," as long as "notice thereof, with

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[1] The current fee for expedited processing is $800. 37 C.F.R. 201.3(d)(7).

[2] In general, "United States work[s]" are works created in the United States or exclusively by domestic authors. 17 U.S.C. 101.

a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Within the 60-day period after such notice has been served, the Register may intervene "with respect to the issue of registrability of the copyright claim." *Ibid.*

The Copyright Act provides additional incentives for prompt submission of applications to register authors' works. The Act authorizes awards of statutory damages, costs, and attorney's fees to prevailing copyright owners. 17 U.S.C. 504(c), 505. Those remedies generally are available, however, only for acts of infringement that occur *after* the effective date of registration. See 17 U.S.C. 412. In addition, a "certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. 410(c).

2. Petitioner Fourth Estate Public Benefit Corporation generates news articles, which it licenses to various websites while retaining ownership of the copyrights. Pet. App. 2a. Respondents Wall-Street.com and its owner initially published petitioner's articles online pursuant to such a licensing agreement. *Ibid.* Petitioner alleges, however, that after respondents cancelled the agreement, they continued to display the articles on their website without petitioner's permission. *Ibid.*

In early March 2016, petitioner deposited a number of those articles with the Copyright Office and submitted an application and fee for registration of a computer database. See App., *infra*, 3a-4a. "For purposes of copyright registration, a database is defined as a compilation of digital information" where the "selection, coordination, and/or arrangement of data or other component elements within the database is sufficiently creative to

warrant registration." *Compendium* §§ 1117.1, 1117.2. Petitioner did not request expedited processing of its claim.

Days later, before the Register had acted on the application, petitioner filed this copyright infringement suit. Pet. App. 15a-22a. The Copyright Office subsequently informed petitioner that its initial check for the application fee could not be processed. App., *infra*, 1a-2a. On April 11, 2016, the Copyright Office received a collectable fee and commenced examining petitioner's application materials. See *id.* at 3a-4a.

3. a. While petitioner's application for registration remained pending, the district court dismissed the complaint without prejudice. Pet. App. 11a-14a. The court explained that, although Section 411(a)'s registration requirement "is no longer a jurisdictional requirement" for a copyright-infringement suit, "it is nonetheless a procedural bar to infringement claims." *Id.* at 12a. The court rejected petitioner's argument that having "an application to register * * * pending at the time of the suit" was "sufficient to survive a motion to dismiss." *Ibid.*

b. The court of appeals affirmed. Pet. App. 1a-10a. The court recognized that the question presented here has "split the circuits." *Id.* at 4a. The court explained that the Tenth Circuit "follows the 'registration' approach * * * , which requires a copyright owner to plead that the Register of Copyrights has acted on the application [for registration]—either by approving or denying it—before a copyright owner can file an infringement action." *Ibid.* (citing *La Resolana Architects, PA* v. *Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier*, *supra*). On the other hand, the court ob-

served, the Fifth and Ninth Circuits "follow the 'application' approach, which requires a copyright owner to plead that he has filed 'the deposit, application, and fee required for registration,' 17 U.S.C. § 411(a), before filing a suit for infringement." *Ibid.* (citing *Cosmetic Ideas, Inc.* v. *IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir.), cert. denied, 562 U.S. 1062 (2010); *Positive Black Talk Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier, supra*).

The court of appeals noted that its own circuit precedent had previously endorsed the registration approach. Pet. App. 6a (citing *Kernel Records Oy* v. *Mosley*, 694 F.3d 1294 (11th Cir. 2012), cert. denied, 569 U.S. 919 (2013)). Petitioner argued that this Court's decision in *Reed Elsevier, supra*, holding that Section 411(a) does not establish a jurisdictional requirement, had "eroded the rationale for following the registration approach." Pet. App. 6a. The court reexamined the question, however, and reaffirmed its view that Section 411(a) bars a copyright owner from instituting an infringement action until the Register has either approved or refused registration. *Id.* at 6a-9a.

The court of appeals concluded that, under the Copyright Act, "'registration of a copyright ... has not been made in accordance with ... title 17' * * * until 'the Register ... registers the claim.'" Pet. App. 6a (quoting 17 U.S.C. 410(a), 411(a)) (alterations omitted). The court explained that "[t]he Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* Although the Act requires the owner to commence the registration process by submitting a deposit, application, and fee, it directs that Office to "examine[]" the

submissions and to "determine[]" whether the work is copyrightable before approving or refusing registration. *Ibid.* Under the Act's plain meaning, the court concluded, "[f]iling an application does not amount to registration." *Ibid.* The court rejected petitioner's arguments regarding "legislative history and policy" as insufficient to overcome that plain meaning. *Id.* at 9a.

4. In August 2017, after the court of appeals' mandate had issued, the Copyright Office notified petitioner that the Register had refused registration. App., *infra*, 3a-9a; cf. Pet. Reply Br. 2 n.1. Noting that petitioner had sought registration on the ground that its articles comprised a database, the Copyright Office explained that the registrability of a database, like that of a compilation, depends on whether the selection and arrangement of those elements qualifies as a work of authorship. App., *infra*, 7a. Among other grounds for rejection, the Office concluded that the selection and arrangement of petitioner's database, in which individual articles were arranged in chronological order, lacked sufficient originality to warrant registration. *Id.* at 7a-8a. The Office further noted that, because the check that petitioner had initially tendered with its application was uncollectable, the effective date of registration would have been April 11, 2016, when the proper fee was received. *Id.* at 3a-4a.

DISCUSSION

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with" Title 17, or (2) the required deposit, application, and fee have been "delivered to the Copyright Office in proper form" and "registration has been

refused." 17 U.S.C. 411(a). The court of appeals correctly affirmed the dismissal of petitioner's copyright-infringement suit because petitioner had filed its complaint before the Register of Copyrights had either approved or refused petitioner's application for registration. This Court's review is warranted, however, because the decision below implicates a longstanding circuit conflict on an important and recurring question of copyright law. The petition for a writ of certiorari therefore should be granted.

A. The Question Presented Is The Subject Of An Entrenched Circuit Conflict That Warrants Resolution By This Court

1. In construing Section 411(a), the Eleventh and Tenth Circuits have adopted the "registration approach," under which the Register must approve or refuse registration before a copyright owner may commence an infringement suit. See Pet. App. 1a-10a; *La Resolana Architects, PA* v. *Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010). The Fifth and Ninth Circuits, by contrast, have taken the "application approach" advocated by petitioner, under which "receipt by the Copyright Office of a complete application satisfies the registration requirement of § 411(a)." *Cosmetic Ideas, Inc.* v. *IAC/InteractiveCorp*, 606 F.3d 612, 621 (9th Cir.), cert. denied, 562 U.S. 1062 (2010); see *Positive Black Talk, Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier*, *supra*; see also *Action Tapes, Inc.* v. *Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006) (indicating that delivery of deposit, application, and fee is necessary for suit, without specifying that it is alone sufficient). The existence of

that circuit split has been widely recognized by courts of appeals, see, *e.g.*, *Psihoyos* v. *John Wiley & Sons, Inc.*, 748 F.3d 120, 125 (2d Cir. 2014); *Alicea* v. *Machete Music*, 744 F.3d 773, 779 (1st Cir. 2014); *Brooks-Ngwenya* v. *Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009) (per curiam); *La Resolana*, 416 F.3d at 1201-1202, and the competing views have been analyzed at length by the two leading copyright treatises, compare 5 William F. Patry, *Patry on Copyright* § 17:78 (2017) (Patry) (advocating the registration approach), with 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3] (2018) (proposing a variant of the application approach).

2. The question presented warrants this Court's review. The issue has arisen frequently in the lower courts, including in numerous reported court of appeals decisions over the past several years. See pp. 9-10, *supra*; Patry § 17:78 nn.10-12 (collecting decisions addressing the issue from every circuit). There is no realistic possibility that the circuit conflict will be eliminated without this Court's intervention. In the court of appeals, petitioner argued that the Court's decision in *Reed Elsevier* cast doubt on the Eleventh Circuit's prior analysis of the question. The court below rejected that argument, however, and we are aware of no court that has understood *Reed Elsevier* in the manner that petitioner advocates. See Patry § 17:78, at 17-232 & n.13.60 ("Courts have continued to reject the application approach after the Supreme Court's *Reed Elsevier* opinion.") (collecting cases).

3. This case is a suitable vehicle for resolving the question presented. The district court dismissed petitioner's suit based solely on petitioner's acknowledg-

ment that it had not obtained a registration determination from the Register of Copyrights. Pet. App. 11a-14a. The court of appeals affirmed on that basis alone. *Id.* at 22-6a.

Although the Register completed her examination process and refused petitioner's application for registration after the court of appeals issued its decision, see App., *infra*, 3a-9a; p. 8, *supra*, the case continues to present a live controversy. Section 411(a) specifies that a copyright owner may not "institute a civil action for infringement" until the statutory prerequisites have been satisfied. 17 U.S.C. 411(a). Under the registration approach adopted by the court of appeals, the district court was correct to dismiss the complaint without prejudice because petitioner had not secured a registration determination before filing the complaint. To be sure, under either of the competing views of Section 411(a), the Register's refusal of registration leaves petitioner free to commence a *new* copyright-infringement suit. The choice between those two interpretations, however, remains relevant to the determination whether petitioner's *current* suit can go forward.

The Register's decision also does not counsel against further review in this case as a prudential matter. The question presented here concerns the proper disposition of an infringement suit that is brought after the copyright owner has applied for registration, but before the Copyright Office has approved or rejected that application. Given the relative speed with which registration decisions are rendered compared to the pace of federal litigation, this Court likely could not resolve that question in any future case before the Copyright Office has acted on the relevant application for registration.

The fact that the Copyright Office initially could not process petitioner's fee (see App., *infra*, 1a-2a) likewise would not prevent this Court from resolving the circuit conflict. The question presented (Pet. i) is whether the owner's action of delivering the "required application, deposit, and fee to the Copyright Office" constitutes "registration of the copyright claim" within the meaning of Section 411(a). The district court and court of appeals decided the case on the assumption that, at the time the suit was commenced, petitioner had delivered those materials to the Copyright Office, but the Register had not yet approved or refused the application for registration. 17 U.S.C. 411(a). Because this case was resolved on a motion to dismiss, the district court was required to accept as true petitioner's allegations to that effect. Pet. App. 18a. This Court may review the court of appeals' decision on the same assumption.

B. Under Section 411(a), A Copyright-Infringement Suit May Not Be Filed Until The Register Of Copyrights Has Either Approved Or Refused Registration Of The Work

The text, structure, and history of the Copyright Act confirm that the Register must have acted on an application for copyright registration—either by approving or refusing registration—before the copyright owner may institute a copyright-infringement suit. Petitioner's contrary arguments are unavailing.

1. In construing Section 411(a), the Court should begin its "inquiry with the text, giving each word its ordinary, contemporary, common meaning," and should "look to the provisions of the whole law to determine [the section's] meaning." *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (citations and internal quotation marks omitted). Section 411(a)

states that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). Although Section 411(a)'s requirements are not jurisdictional, the provision "imposes a precondition to filing a claim" of infringement. *Reed Elsevier*, 559 U.S. at 166. Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," 17 U.S.C. 411(a), only when the Register has approved an application.

a. The term "registration" in Section 411(a) is most naturally read to refer to the Copyright Office's official recording of an accepted copyright claim. Both at the time of Section 411(a)'s enactment and today, the term "registration" signified (and signifies) an authoritative act of "[r]ecording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see *Webster's Third New International Dictionary* 1912 (1966) ("something registered" or "an entry in a register"); see also *Black's Law Dictionary* 1474 (10th ed. 2014) ("The act of recording or enrolling."). Where copyrighted works are involved, "registration" denotes the act of the eponymous Register of Copyrights in entering a claim of copyright into an official register. See *Compendium*, Glossary 14 ("Registration involves examining the claim, and if the claim is approved by the U.S. Copyright Office, numbering the claim, issuing a certificate of registration, and creating a public record.").

Section 411(a)'s requirement that "registration" have been "made in accordance with this title" reinforces this natural meaning. 17 U.S.C. 411(a). In order for a copyright to be registered, the owner of a copyrighted work must deliver a deposit, application, and fee to the Copyright Office. See 17 U.S.C. 408, 409. Registration "in accordance with" Title 17 occurs only "after examination" of those submissions by the Register, who then "determines" whether the submissions are "acceptable for registration." 17 U.S.C. 410(a) and (d). Only then does the Register "register the claim," by recording the work as copyrightable, and "issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a); see 17 U.S.C. 411(b) (explaining that this "certification of registration satisfies the requirements of [Section 411(a)]"). Thus, in the ordinary case, "both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977 (2014).

The second sentence of Section 411(a), which creates an exception to the registration requirement, underscores that conclusion. That sentence provides: "In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Thus, an applicant who has submitted a proper application package may file an infringement suit once the Register has issued a final decision refusing registration. That exception would be superfluous

if an applicant was entitled to commence suit as soon as he had submitted the required materials.

Petitioner reads (Pet. 19) Section 411(a)'s second sentence to mean that, although a copyright owner may initiate suit as soon as the required materials have been submitted, he must notify the Register about the suit if the Register refuses registration while the litigation is ongoing. But if Congress had intended that result, it could have required the copyright owner to provide notice to the Register in order to "maintain" or "continue with" the suit. Section 411(a)'s second sentence instead provides that, in circumstances where registration has been refused, "the applicant is entitled to *institute* a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a) (emphasis added). That language assumes that, in cases where the Register refuses registration, the requisite notice to the Register will be provided at the time suit is commenced.

Petitioner's approach would also subvert the congressional purpose that underlies Section 411(a)'s *third* sentence, which authorizes the Register to intervene in cases where registration is refused. See 17 U.S.C. 411(a) (authorizing the Register to "become a party to the action with respect to the issue of registrability of the copyright claim" when she has refused registration). The evident purpose of that provision is to ensure that the Register can explain to the court in the infringement suit why she concluded that the requirements for registration were not satisfied. That provision could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially could decide the case on the merits, before the

Register had either rendered her registration decision or received the mandated notice.

b. Other Copyright Act provisions reinforce the court of appeals' interpretation of Section 411(a)'s registration requirement. See, *e.g.*, *Mellouli* v. *Lynch*, 135 S. Ct. 1980, 1989 (2015) ("Statutes should be interpreted 'as a symmetrical and coherent regulatory scheme.'") (citation omitted); *Clark* v. *Rameker*, 134 S. Ct. 2242, 2248 (2014) ("[A] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous.") (citation omitted).

The Copyright Act describes the copyright owner's submission of his deposit, application, and fee to the Copyright Office as an "application for registration." 17 U.S.C. 408(f)(3) (capitalization altered); see *Black's Law Dictionary* (1968), *supra*, at 127 (defining "application" as "[t]he act of making a request for something"). That language assumes that submission of the required materials is an action distinct from "registration" itself. Petitioner's approach is also inconsistent with Section 410(d), which specifies the effective date of a copyright registration. Under that provision, the "effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d). If "registration of [a] copyright claim" were "made" on the date those materials are submitted, 17 U.S.C. 411(a), there would be no need for the back-dating rule of Section 410(d).

Petitioner's approach would also render substantially meaningless the Copyright Act's "preregistration" regime for certain works. See 17 U.S.C. 408(f).

Preregistration is available for limited classes of unpublished commercial works (such as prerelease versions of mainstream films) that the Copyright Office determines have a history of infringement before commercial distribution. *Ibid.* After the Copyright Office conducts a truncated review based on a description of the unpublished work, see 17 U.S.C. 408(f)(2); 37 C.F.R. 202.16(b)(1) and (c), Section 411(a) permits the copyright owner to sue based on preregistration. The preregistration regime ensures that, for these limited classes of works, the time required for the Register to examine and register the work does not preclude the copyright owner from obtaining an effective judicial remedy. But if a copyright owner could file an infringement suit as soon as it had delivered the required deposit, application, and fee to the Copyright Office—*i.e.*, if the time required for the Register to examine and register a work would *never* delay the commencement of suit—there would be little need for the preregistration scheme.

c. The history of the Copyright Act likewise supports the court of appeals' interpretation of Section 411(a).

The Copyright Act of 1909 provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with." Act of Mar. 4, 1909, ch. 320, § 12, 35 Stat. 1078. Courts interpreted that language as requiring dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration, even if the proper deposit had been made. See, *e.g.*, *Lumiere* v. *Pathe Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921) (affirming dismissal of suit

and explaining that, "[w]hen this bill was filed, two copies of each of the [copyrighted] photographs had been deposited, but the registration required by the act had not been obtained"); *Algonquin Music, Inc.* v. *Mills Music*, 93 F. Supp. 268, 268 (S.D.N.Y. 1950); *Rosedale* v. *News Syndicate Co.*, 39 F. Supp. 357, 357 (S.D.N.Y. 1941). The Second Circuit explained that the 1909 Act required compliance with statutory provisions governing "'registration of [the] work'" as well as with those governing "'deposit of copies,'" and that the court could "think of no other added condition for 'registration' but acceptance by the Register." *Vacheron & Constatin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637, 640-641 (1958) (Hand, J.) (citation omitted). Indeed, even after registration had been refused, a copyright owner was required to obtain a writ of mandamus compelling the Register to grant registration of its copyright before instituting an infringement suit. See *id.* at 639 ("Title 17 forbade any action for infringement of the copyright when the Register of Copyrights had refused * * * to accept [it]."); *id.* at 640 (discussing the use of mandamus in this context).

In 1976, Congress enacted Section 411(a) against the backdrop of this rule. See Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2583. By authorizing a copyright owner to "institute a civil action for infringement" when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," Congress eliminated the need to obtain a writ of mandamus against the Register after such a refusal. 17 U.S.C. 411(a); see H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976) (1976 House Report) ("The second and third sentences of section 411(a) would alter the present law as interpreted in *Vacheron*."). But the

legislative history does not suggest that Congress intended to allow commencement of an infringement suit while the plaintiff's application for copyright registration remains pending. To the contrary, the House Report for the 1976 Act explained that "[t]he first sentence of [S]ection 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." 1976 House Report 157.

2. a. Petitioner contends (Pet. 17-20) that the term "registration" can refer either to the action of the Register in granting registration or to the action of the copyright owner in seeking registration. Petitioner argues (Pet. 18) that the phrase "registration ... has been made" in the first sentence of Section 411(a) refers solely "to the action of the copyright holder." In support of that contention, petitioner invokes (*ibid.*) the second sentence of Section 411(a), which authorizes a copyright owner who has been refused registration to institute an infringement suit. Petitioner contends (*ibid.*) that, if "registration" is "made" only when the Register approves an application, the second sentence of Section 411(a) would "contradict" the first. See *ibid.* ("[A] suit for infringement may be instituted even though registration had *not* been made.").

As explained above, Section 411(a)'s second sentence is best understood as creating an *exception* to the requirement that "registration" must be "made" before an infringement suit may be commenced. To be sure, Congress could have communicated more precisely the relationship between the provision's first two sentences. But the word "however" in the second sentence at least makes clear that Congress understood that sentence as a departure from, or qualification of, the rule announced

in the sentence that precedes it. Taken as a whole, Section 411(a) provides that a copyright owner may initiate infringement litigation if he has submitted a compliant application and the Register has acted on that application, either by granting or denying it. There is nothing substantively contradictory about that regime.

Under petitioner's approach, moreover, the term "registration" would have a quite different meaning in Section 411(a)'s second sentence than it has in the first. Petitioner construes (Pet. 18) that term in the first sentence to refer solely "to the action of the copyright holder." But the second sentence, which addresses cases in which "registration has been refused," clearly uses the term to refer to the Register's disposition of the application, not to the copyright owner's submission of it. "[I]dentical words and phrases within the same statute should normally be given the same meaning," *Hall* v. *United States*, 566 U.S. 506, 519 (2012) (citation omitted), and that common-sense understanding applies with particular force when the same word appears in consecutive sentences of a single statutory subsection.

b. Citing a handful of other Copyright Act provisions that contain some variant of the phrase "making registration" or "registration having been made," petitioner contends (Pet. 20) that those provisions are most naturally read to refer to action by the copyright owner. See Pet. 20-21 (citing 17 U.S.C. 408(c)(3) and (e), 411(c), 412(2)). But the court below did not suggest that the copyright owner's actions are divorced from the process by which copyright "registration" is "made." The court simply recognized that, even after the copyright owner has done his part, "registration" can be "made" only after the Register does hers.

Other Copyright Act provisions use the phrase "registration has been made" (or a close variant) to refer to circumstances in which the entire registration process, including the Copyright Office's disposition of the copyright owner's application to register his work, has been completed. The Act provides that recording the transfer of ownership of a copyrighted work with the Office gives the public "constructive notice" of ownership once "registration has been made for the work." 17 U.S.C. 205(c). In certain circumstances, a copyright infringer who began the infringement in good faith under a purported license from someone other than the copyright owner has a "complete defense" to infringement liability unless "registration for the work had been made in the name of the owner of copyright." 17 U.S.C. 406(a). These constructive-notice provisions assume that, once "registration has been made," a public record will have been created. That will be true if, but only if, "registration" is "made" when the Register approves an application and the Copyright Office enters the registration into its records catalog. See 17 U.S.C. 705; p. 3, *supra*.

c. Petitioner contends (Pet. 23-24) that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, "it makes little sense to place a copyright holder in months of 'legal limbo' while the examination of a registration application is completed." But while Section 411(a) allows a copyright owner to sue regardless of the Copyright Office's conclusion as to registrability, the court in adjudicating an infringement suit still can benefit from knowing what that conclusion is. And by deferring the initiation of suit until the Register has determined whether a work is registrable, the

Act provides a significant incentive for copyright owners to begin the registration process promptly after publication, rather than waiting until an infringement dispute arises.

Petitioner also expresses concern (Pet. 26) about the potential practical consequences of the court of appeals' construction of Section 411(a). Those consequences include the unavailability of injunctive relief until the Register has ruled on the application; the possible running of the statute of limitations; and the potential loss of evidence. But Congress has provided various means of mitigating these risks, while maintaining a strong incentive for prompt submission of applications to register copyrights. See, *e.g.*, 17 U.S.C. 408(f), 411(a) (conferring immediate right to sue after preregistration); 17 U.S.C. 411(c) (conferring immediate right to sue for infringement of live broadcasts); 17 U.S.C. 412 (permitting statutory damages and attorney's fees dating back to the filing of an application for registration); see also *Compendium* § 623.4 (permitting expedited consideration for registration of all works).

In any event, the text of Section 411(a), and of the Copyright Act as a whole, is the best indication of the balance between competing objectives that Congress sought to draw. Any adjustment of that balance is properly entrusted to Congress rather than to this Court.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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MALCOLM L. STEWART
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JASON E. SLOAN
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United States Copyright Office

MAY 2018

APPENDIX A

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Apr. 4, 2016

William Brown
922 Honeytree Lane, Apt. A
Wellington, FL 33414

Correspondence ID: 1-1I3Z4PR

RE: Group Registration . . . "Fourth Estate Public Benefit Corporation News Articles" Published January 1, 2016 to February 29, 2016—updated hourly.

Dear Mr. Brown:

We received your application, deposit, and payment to register your copyright claim. We are writing because the check you sent in payment of the filing fee was rejected by your bank as an uncollectible item.

If you wish register this claim, you must provide a new filing **fee.** In **addition,** the Office charges **$30.00** to service an uncollectible check. The full amount due is **$115.00.** You may send a check or money order with the accompanying reply sheet. Alternatively, you may pay the amount by credit card. See instructions on the reply sheet.

It is recommended that you respond as quickly as possible to establish an early effective date of registration. The effective date of registration for claims to copyright is established upon receipt of an application, deposit, **and valid filing fee.**

If we have not received your payment or credit card information within **45 days** of the date of this letter, we will cancel your registration. After that time, in order to register, you will have to file an entirely new claim, consisting of an application, deposit, and valid filing fee. If you have questions, please call 202-707-8443.

Sincerely,

Accounts Section
Receipt Analysis & Control Division
202-707-8443

Enclosure:
Copy of remittance
Reply Sheet
SL-4

APPENDIX B

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Aug. 04, 2017

William Brown
922 Honeytree Lane, Apt A
Wellington, FL 33414

Correspondence ID: 1-2M4Y45H

RE: *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* (1-3223995975)

Dear William Brown:

We are writing to refuse registration for *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* ("the work") because this submission does not meet the legal or formal requirements for registration under the group database option or any other application option currently available.

Procedural History

Fourth Estate Public Benefit Corporation ("Fourth Estate") submitted this application, which was received on or about March 7, 2016. Due to Fourth Estate's

initial submission of an uncollectable check, the $85.00 filing fee was not received until April 11, 2016.

The receipt of a completed application, the appropriate fee, and an acceptable deposit can establish an effective date of registration (EDR) for purposes of title 17, section 410(d). But the establishment of that date is contingent on the issuance of a certificate of registration following the requisite examination for copyrightability and the legal and formal requirements of title 17, section 410(a). If the Office refuses registration, after determining compliance with the requirements of section 410(a), a court of competent jurisdiction may later find the work to be copyrightable and rely on the filing date as the EDR for purposes of title 17, section 412. 17 USC § 410(d).

In this case, not only did the uncollectable check delay the examination of this work and remove the claim from the U.S. Copyright Office's ordinary workflow, it also changed what would have been the effective date of registration, if the claim were ultimately registered, to the date when the proper fee was received by the Office.

Discussion

You have submitted multiple articles for registration with this application. As a general rule, a registration covers an individual work, and an applicant must submit a separate application, filing fee, and deposit copy for each work that is submitted for registration. In some cases, an applicant may register several works together on one application if one of the following limited exceptions applies: registering multiple works as a collective work, as an unpublished collection, as a "unit of

publication," or using one of several group registration options. For an in-depth discussion on the options for registering multiple works, see *Compendium of U.S. Copyright Office Practices*, Third Edition Chapter 1100.

In this case, it appears you have submitted these works for registration under the group database option. For purposes of copyright registration, a database is defined as a compilation of digital information comprised of data, information, abstracts, images, maps, music, sound recordings, video, other digitized material, or references to a particular subject or subjects. In all cases, the content of a database must be arranged in a systematic manner, and it must be accessed solely by means of an integrated information retrieval program or system with the following characteristics:

- A query function must be the sole means of accessing the contents of the database.
- The information retrieval program or system must yield a subset of the content, or it must organize the content based on the parameters specified in each query.

When seeking registration for a database or group registration of periodic revisions to a database, the applicant must deposit identifying portions of the updated content, with 50 representative pages marked to disclose the new material added on one representative publication date, along with a copy of the copyright notice (if any). In addition, an application for a group registration must include a descriptive statement containing specific information identified in the Office's regulations. *See* 37 CFR § 202.20(c)(2)(vii)(D).

For registration purposes, a database must be a copyrightable compilation, which is defined in the statute as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 USC 101 (definition of "compilation"). A database containing component works is considered a collective work, which is defined in the statute as a type of compilation. 17 USC 101 (definition of "collective work"), ("The term compilation includes collective works.") As such, the principal question in an application for registration of a database or group registration of periodic revisions to a database is whether there is sufficient creative selection, coordination, and/or arrangement of the elements to qualify as an original work of authorship. A database containing component works must demonstrate creative selection, coordination, and/or arrangement of the component works to be registrable as a copyrightable database. The copyrightability of component elements contained within a database will not suffice to demonstrate that a database is copyrightable or that multiple elements or works may be registered together in one application. Where sufficient creativity in the selection, coordination, and/or arrangement of elements is not demonstrated in the deposit material, the application for registration must be refused.

In this regard, the group database registration option is different from the Office's other group registration options. When the Office issues a registration for a group of published photographs or contributions to periodicals, the registration covers each individual on a separate basis and the group as a whole is not consid-

ered a compilation, a collective work, or a derivative work. 37 CFR 202.4(m); *Compendium* § 1104.4.

By contrast, the group database option covers new derivative versions of the selection, coordination, or arrangement of elements within the database. In essence, each update with the group is registered as a derivative compilation and/or derivative collective work. *Compendium* § 1104.4.

The critical copyrightable element in a compilation or collective work is not the copyrightability of individual elements, but rather the sufficiency of creative authorship in the selection, coordination, and/or arrangement of elements or works, such that the work as a whole qualifies as an original work of authorship in accordance with the principles of the statute and the decision in *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

The works you seek to register are multiple, separately published textual contributions. Although the application does not provide a year of completion or a date of first publication, the title space states that the contributions were published from January 1, 2015 through February 29, 2016 and that updates occur "hourly." The application describes the nature of authorship as "new matter: new text & revisions" and states that the work was not previously registered. The deposit material consists of separate articles, with publication dates ranging from January 1, 2016 through January 4, 2016.

The individual news articles submitted as the deposit material were submitted separately, and were selected and arranged in a manner that utterly lacks originality: in chronological order. As submitted, these articles

do not reveal any selection, coordination, and/or arrangement to support a claim to copyright in a compilation. Further, the registration materials do not demonstrate that these individual articles are even a part of a database. Instead, the articles appear to be from a news website. The *Compendium of U.S. Copyright Office Practices* clarifies the significant distinction between databases and websites for registration purposes. *Compendium* § 1002.6. Finally, Fourth Estate's application claims only in new text and revisions, and does not include a claim in selection, coordination, and/or arrangement. Therefore, as there is no original selection, coordination, and/or arrangement authorship evident in the registration materials, this submission is not eligible for registration under the group database and registration, as a compilation generally, or as a collective work. As a result, this claim must be refused.

In addition to the reasons discussed above, it is important to note that this application is deficient in meeting the formal requirements of the group database option in a number of other ways. Namely, Fourth Estate has not submitted the required Descriptive Statement; the application does not provide a representative publication date; and it lacks a limitation of the claim statement that would be necessary in relation to the application's references to "new matter" and "revised text" in the authorship statement. Were these the only defects in the application for registration, the application could be cured through correspondence and a submission of the omitted required information. However, in light of the inability for the work to qualify under the group database option, and the fact that the work does not qualify as a compilation or collective work, an at-

tempt to cure the application as submitted would be futile.

In order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office together with the proper application and proper fee. If the Office receives all of the required elements in proper form, it will examine the applications and the deposits to determine whether the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of title 17 have been met. If there is a need for expedited examination of such new applications, you may request special handling during the electronic application process or in writing with a paper application, explaining the basis for your need for expedited examination, together with payment of the required fee for this service.

This letter is for your information only. No reply is required. Should you choose to request administrative reconsideration of this decision, please follow the instructions on the enclosed reply sheet.

Sincerely,

Elizabeth Stringer
Supervisor
Literary Division
U.S. Copyright Office

Enclosures:
Reply Sheet